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EXAMINER	
STRANGE, AARON N	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/819,244	Applicant(s) UEDA, SATORU	
	Examiner Aaron Strange	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In light of the lengthy prosecution history of the present application, the Examiner would like to express willingness to conduct an interview to discuss the present application. The Examiner feels that an interview may help facilitate a mutual understanding of the respective positions of Applicant and the Examiner, and assist in the identification of allowable subject matter and/or issues for appeal. In the event that Applicant agrees that an interview would be beneficial, he/she is encouraged to contact the Examiner to schedule one.

Response to Arguments

2. Applicant's arguments filed 9/4/07 have been fully considered but they are not persuasive.

3. With regard to claim 1, and Applicant's assertion that Borwankar fails to describe or suggest that "the communication contents storage means stores the communication history of the electronic mail" (Remarks 9-10), it is noted that the rejection of claim 1 was based on the combined teachings of NG, Zabetian and Borwankar. Borwankar was cited only for teaching storing a communication history of an electronic mail, generally, and was not intended to be bodily incorporated into Ng and/or Zabetian.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, the combined teachings of Ng and Borwankar would have taught and/or suggested storing a communication history of the electronic mail in the communication contents storage means to ensure that the history of each stored message is available.

4. With further regard to claim 1, and Applicant's assertion that the combination of Ng, Zabetian, and Borwankar does not teach or suggest "a contract is formed between the first party and the second party for using the communication contents certification system, via the contents certification system, prior to transmitting a certified transmission" (Remarks, 10), the Examiner respectfully disagree. Zabetian expressly teaches all parties making a contract for using the system, prior to using the system to transmit a certified message (users register with the system, prior to use, in order to be identified)(col. 6, ll. 38-42, 54-67).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. With regard to claim 9, the limitation "a computer-readable information recording medium that is *adapted to* store a computer program" is unclear. It is unclear if the claimed program is actually stored on the medium or whether the medium will merely record the program at some later time. The Examiner recommends amending the claim to recite "a computer-readable information recording medium, having stored thereon:" or a similar limitation making it clear that the software code is stored on a statutory article of manufacture.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Zabetian et al. (6,327,656) further in view of Borwankar (US 6,594,693).

10. With regard to claim 1, Ng discloses a communication contents certification system for certifying contents of an electronic mail, comprising:

a communication contents certification apparatus (Email web site) (Fig 4, 20') having communication contents receiving means for receiving said electronic mail (messages are received through email web site) (Col 6, Lines 42-46), communication contents storage means for storing the contents of said electronic mail (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42), communication contents transmission means for transmitting said electronic mail (Messages are sent through email web site) (Col 6, Lines 42-46), and charging means for charging a fee associated with use of the communication contents certification apparatus (Col 14, Lines 21-26);

a first party communication terminal coupled to the communication contents certification apparatus (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58);

a second party communication terminal coupled to the communication contents certification apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58);

a first attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65);

a second attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65); wherein:

wherein the electronic mail is transmitted from a first party communication terminal to at least one of an attorney communication terminal and another of the party communication terminals such that the electronic mail is routed to the communication contents certification apparatus and the communication contents certification apparatus

obtains authentication information for the electronic mail, and stores the contents of the electronic mail (email is sent via the certification apparatus) (Col 8, Lines 19-29), and

wherein a reply message in response to a received electronic mail is prepared for every electronic mail transmission (at least Col 10, Lines 25-27; Fig 8D).

Ng fails to specifically disclose obtaining an identification and password of a sending party to authenticate the contents of the electronic mail, preparing a reply message with reference to a comment provided from one of the attorney communication terminals, charging means for charging at least one of the parties for authenticating and/or certifying the contents of the electronic mail, that the communication contents storage means stores the communication history of the electronic mail, or that a contract for using the system is formed between the first and second parties prior to transmitting a certified transmission..

Zabetian discloses a similar system for certifying electronic mail and teaches authenticating the electronic mail based on an identification (source address) (Col 6, Lines 38-45) and password of the sending party (Col 6, Lines 63-64). Zabetian further teaches billing a user of the system (Col 6, Lines 45-49) and the first and second users forming a contract for using the system prior to transmitting any certified messages (users register with the system, prior to use, in order to be identified)(col. 6, ll. 38-42, 54-67). This would have been an advantageous addition to the system disclosed by Ng since it allows the sender of the message to be positively identified, ensuring that the message actually came from a particular person, and allowing that use to be billed for using the system.

Bonwankar discloses a similar system for sending electronic mails between persons on a network and teaches storing the communication history of the electronic mails (at least Col 3, Lines 56-60). This would have been an advantageous addition to the system disclosed by Ng and Zabetian since it would have allowed users to save their messages and access them at a later time to see desired portions of their conversation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an identifier/password combination to authenticate and bill the contents of an electronic mail and store the communication history of the electronic mails.

While Ng fails to specifically disclose preparing the reply message with reference to a comment provided from one of the attorney communication terminals, the content of the messages sent and received via the system is nothing more than non-functional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). In this case, the difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material, which is presumed to be well within the level of ordinary skill in the art at the time the invention

was made. See *Ex Parte Curry*, Appeal No. 2005-0509 (Appl. No. 09/449,237) (*aff'd*, Appeal No. 06-1003 (Fed. Cir. Jun. 12, 2006)(Rule 36)(unpublished)).

11. With regard to claim 2, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), including a GUI (Col 8, Lines 20-22), a party button display section for selecting electronic mail communication with the second party communication terminal wherein the first party communication terminal is adapted to transmit the electronic mail as a function of input to the GUI (Clicking on "Authenticated Send" button sends message to second party via certification apparatus)(Col 8, Lines 25-29), it fails to specifically disclose an attorney button display section for selecting electronic mail communication with said first attorney communication terminal.

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an attorney button display because Applicant has not disclosed that a dedicated attorney button display provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well by specifying the attorney's email address and using the "Authenticated Send" button as disclosed by Ng (Col 8, Lines 19-29 and Fig 8A-8D) because both methods perform the required task of sending the message to the user's attorney via the certification apparatus equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Ng to obtain the invention as specified in claim 2.

12. With regard to claim 3, Ng further discloses that the contents of the electronic mail relate to a contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

13. With regard to claim 4, Zabetian further discloses a method of confirming the reception of an electronic mail by having the recipient notify the certification requester (the certification apparatus in this case) upon successful receipt of the message. Zabetian discloses that this can be accomplished through a conventional return receipt or through an active login procedure to the email web site (Col 11, Line 63 to Col 12, Line 16).

14. With regard to claim 5, Ng further discloses that the electronic is encrypted (Col 14, Lines 45-47).

15. With regard to claim 6, Zabetian further discloses several methods of registering users for email service so their identity can be confirmed (Col 6, Line 54 to Col 7, Line 3).

16. Claims 7 and 8 are rejected for the same reasons as claims 1 and 3, since they recite subject matter which is wholly contained within those claims.

17. Claim 9 is rejected for the same reasons as claim 1, since it recites subject matter which is wholly contained within claim 1. Since the system disclosed by Ng is executed on computers, a computer readable recording medium holding the software to perform the method of claim 9 is inherent.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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AS
12/19/07



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